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**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600**

**DECISION
ON PETITION**

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

In re Application of: :
NOMURA, YASUO, et al. :
Application Serial No.: 09/771,557 :
Filed: January 30, 2001 :
For: INFORMATION PROCESSING APPARATUS :
AND METHOD AS WELL AS PROGRAM STORAGE :
MEDIUM :

This is a decision on the petition to withdraw finality of office action filed December 19, 2006, pursuant to 37 CFR § 1.181.

Petitioner contends that the Office action mailed October 19, 2006 should not have been made final because applicants had no previous means by which to examine the Hashizume parent application absent the supply of this application from the USPTO.

A review of the file indicates a non-final rejection was made on April 6, 2006. In the office action, claims 1,2,4-6 were lined through and replaced with claims 1-11 and the rejection under 102(a) was lined through and replaced with 103(a), thus making the statement claims 1-11 are rejected under 35 USC 103(a) as being unpatentable by Hashizume et al in view of Seo. The applicant responded by filing an amendment/remarks on August 3, 2006. None of the claims have been amended. In the remarks, applicants made the conclusion, that since Hashizume is a continuation in part of an earlier filed application, there are aspects of the Hashizume disclosure, which are not entitled to the September 10, 1998 priority date. Since applicants were unable to obtain this information on their own, they are not in a position to address the propriety of the rejection as it relates to the appropriate priority date of the Hashizume reference and therefore a prima facie case of obviousness has not been presented. The examiner responded with a final rejection on October 19, 2006. In the final rejection, the rejection statement made was "Claims 1, 2, 4-6 are rejected under 102(a) as being unpatentable by Hashizume et al in view of Seo". In the remarks, the examiner states, "Please find enclosed the application 09/150,235 that establishes the priority of Hashizume et al (US 2003/0142955) reference to September 10, 1998. The rejection is maintained."

In reviewing the prosecution history, it is arguable that the examiner did in fact enter a new ground of rejection in the final rejection that wasn't necessitated by amendment. Also, in the final rejection, the examiner, after being queried by the applicant where there is support for the rejection in the parent application 09/150,235, failed to shift the burden back to the applicant by providing proof that the elements/portions that were being relied upon for support in the Hashizume CIP were present in its parent. The examiner merely restated that the CIP in its entirety had priority back to the parent without specificity. Consequently, the finality of the office action of October 19, 2006 is withdrawn.

The petition is **GRANTED**.

The file is being forwarded to the Technology Center's technical support staff for entry of the response filed December 19, 2006 as a response after non-final rejection. From there, the file will be forwarded to the Examiner for preparation of a new action in due course.



Wanda L. Walker, Director
Technology Center 2600
Communications